



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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R2000-115

DEC 13 2000

In re .

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 38 and 39 of the morning section and questions 10, 16, 25, and 28 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On May 30, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 38 and 39 and afternoon questions 10, 16, 25 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 38 reads as follows:

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution.

The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

- (A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.
- (B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.
- (C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.
- (D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.
- (E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

The model answer is choice (A).

Selection (A) is the best answer as per *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because "late claiming" was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753

(Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

Petitioner argues that (B) is correct and (A) is incorrect based on the MPEP version available at the time of the examination. Petitioner contends that the MPEP available at the time of the examination did not discuss that arguments alone can cause surrender of subject matter. Petitioner concludes that answer (A) is incorrect and maintains that answer (B) is correct because of that omission from the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the answer (B) is the best given the information in MPEP available at the time of the invention, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture. The statement in answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that (E) is correct and (C) is incorrect based on the MPEP version available at the time of the examination. Petitioner contends that the MPEP available at the time of the examination did not discuss that arguments alone can cause surrender of subject matter.

Petitioner argues that the model answer (C) includes the case where the limitation now being omitted or broadened in the present reissue was originally argued in the original application to make the claims allowable over a rejection or objection made in the original application, which the prior version of the MPEP was silent on. Petitioner concludes that answer (C) is incorrect

and maintains that answer (E) is correct because of that omission from the MPEP.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the answer (E) is the best given the information in MPEP available at the time of the invention, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture. The statement suffix in answer (C) is correct. **No error in grading has been shown.** Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues (A) is correct and (B) is incorrect. Petitioner contends that a responsible attorney would call the examiner as a heads up and then do whatever is consistent with PTO practice, and that doing nothing is poor practice. Petitioner concludes that answer (B) is incorrect.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that it is good practice to give an examiner a heads up, the answer (A) specifically states that the attorney should advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled. As explained in 35 U.S.C. § 305, reexamination

proceedings are conducted with special dispatch. Accordingly, a registered practitioner is charged with knowing that there is no mechanism for suspending a reexamination proceeding until a bankruptcy is settled, rendering answer (A) incorrect because it asserts an action contrary to PTO rules and practices. The issue of bankruptcy is not relevant to the reexamination proceeding. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. Given that no action is required and a registered practitioner would know not to request suspension of a reexamination proceeding, the statement in answer (B) is correct and the statement in answer (A) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered

practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP version available to the public at the time of the examination on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. Petitioner concludes

that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)." *Monarch Knitting* stated "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art" at 1983, referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp, automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice (B).

Selection (B) is correct as per MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of the power of attorney. 37 C.F.R. § 1.36. Thus. (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

Petitioner argues that I is also correct and therefore answer (D), the answer stating that both

I and II are correct is the best answer. Petitioner contends that I would be correct where state law provided that an in-house corporate counsel may have the inherent ability to revoke powers of attorney. Petitioner concludes that answer (B) is incorrect because I is also correct and maintains that answer (D) is the best answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that state law may provide in-house counsel the inherent right to revoke powers of attorney, the question specifically states that Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp. The instructions explicitly state to not assume any additional facts not presented in the questions. The factual basis for the question states that Joe lacks authority. Accordingly, the question is not premised on state law, but rather PTO rules and regulations, rendering answer (D) incorrect. The statement in answer (B) is correct because II is correct, but not I. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP 1414 Content of Reissue Oath/Declaration and 37 C.F.R. § 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 C.F.R. § 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 C.F.R. § 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 C.F.R. § 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP 1206, pages 1200-8 and 9. As to (B), see MPEP 1002 and the sentence bridging pages 1000-2 and 1000-3. As to (C), 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (A) is correct and (E) is incorrect. Petitioner contends that answer (A) does not say that the only argument made was pointing out differences, but merely that arguments were made. Petitioner argues that answer (A) is correct when combined with the additional action of stating that claims do not stand or fall together and presenting appropriate arguments. Petitioner also argues that answer (E) is incorrect because MPEP § 201.14(b) makes the location of the claim to foreign priority permissive rather than mandatory. Petitioner concludes that answer (E) is incorrect and maintains that answer (A) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that when desiring to claim foreign priority, the oath or declaration in a reissue application need not claim foreign priority even though the priority claim was made in the original patent because MPEP § 201.14(b) is permissive, 37 C.F.R. § 1.63(c) states that the

oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

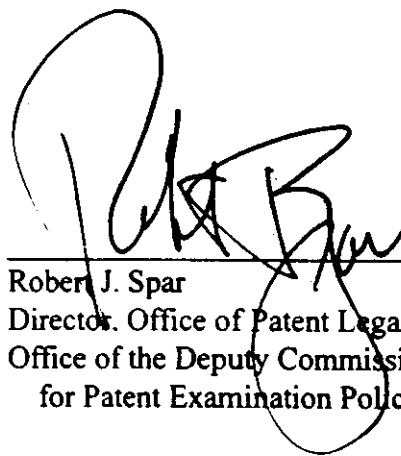
As to answer (A), that answer states each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover. This answer states that it is sufficient to point out differences to have claims stand or fall separately. Petitioner assumes additional facts that are not given in the question. As shown in the model answer, the statement given in answer (A) is not sufficient, rendering answer (A) incorrect. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A large, stylized handwritten signature in black ink, appearing to read 'R. J. Spar', is written over a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy